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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,656	11/24/2001	Peter Klug	2000DE443	5306

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EXAMINER

BERMAN, ALYSIA

ART UNIT PAPER NUMBER

1617

DATE MAILED: 12/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,656

Applicant(s)

KLUG ET AL.

Examiner

Alysia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 16, 17 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Receipt is acknowledged of the information disclosure statement filed January 31, 2002 and the declaration filed February 28, 2002. Claims 1-24 are pending.

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention: an emulsifier.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 2, 4 and 22-24 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

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case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Richard Silverman a provisional election was made with traverse to prosecute the invention of the species of Example 4, polyisobutenylsuccinic anhydride with methytriglycol, claims 3, 5-15, 18, 20 and 21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16, 17 and 19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15, 18 and 20-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are vague and indefinite because claims 1, 5, 6 and 11 recite the word derivative. It is unclear what Applicant intends by the derivatives claims. Neither

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the claims nor the specification provide an exclusive definition of the derivatives encompassed by the claims. The metes and bounds of the claims cannot be determined.

Regarding claim 14, the word "blocklike" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-15, 18 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 87/03613 (613).

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WO '613 is directed to water-in-oil emulsions that comprise an emulsifier, component C, that is a salt of at least one hydrocarbyl-substituted carboxylic acid or anhydride or an ester or amide derivative thereof, C(I) (abstract). C(I) compounds are made from reacting an olefinically unsaturated carboxylic acid reagent with one or more olefin polymers (page 14, 1st full paragraph). Maleic anhydride is the preferred olefinically unsaturated carboxylic acid reagent (page 15, 1st full paragraph). Ester derivatives of the olefinically unsaturated carboxylic acid reagents include ester made by esterifying polyhydric alcohols with the acids and anhydrides (page 15, 1st paragraph). The preferred hydrocarbyl substituent is polyisobutene (paragraph bridging pages 17 and 18). Useful polyhydric alcohols for forming esters of the hydrocarbyl-substituted carboxylic acid or anhydride include alkylene glycols (page 26-27). For polyoxyalkylene glycols with ethylene groups see top of page 27. These polyoxyalkylene glycols encompass methyltriglycol.

WO '613 does not explicitly disclose or exemplify an emulsion comprising the instantly claimed species of emulsifier, a cosmetic or pharmaceutical composition or a composition in the form of an ointment, cream, lotion, gel or spray.

The claims differ from the reference by reciting a specific species and a more limited genus of emulsifier than the reference. However, it would have been obvious to one of ordinary skill in the art to select any of the species of the genus taught by the reference, including those of the claims, with a reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as the genus as a whole. It has been held that a prior art disclosed genus of useful compound

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is sufficient to render *prima facie* obvious a species falling within the genus. In re Susi, 440 F2d 442, 445, 169, USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in Merk & Co. Vs. Biocraft Laboratories, F2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989). Therefore, absent evidence of unexpected results, the particular species of emulsifier is not considered patentable over the prior art.

The preamble of the claims directed to an intended use of the composition does not render the claims patentable over the prior art. Terms merely setting forth an intended use for, or a property inherent in, an otherwise old composition do not differentiate the claimed composition from those of the prior art. Pearson stated that a known composition cannot be patented solely on preamble use. *In re Pearson*, 181 USPQ 641. Difference in use cannot render claimed composition novel. *In re Tuominen*, 213 USPQ 89.

The particular form of the composition does not render the claims patentable over the prior art. It is known in the art that emulsions are routinely supplied in the form of lotions, creams, ointments, gels and sprays. One of ordinary skill in the art would select any reasonable form of the composition for suitable use.

It would have been obvious to one of ordinary skill in the art at the time of the invention to make an emulsion as taught by WO '613 and select the instantly claimed species of emulsifier from the disclosed genus of WO '613 for its emulsifying properties.

Correspondence


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-

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4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
December 14, 2002


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GROUP 1200